

REMARKS

This responds to the Final Office Action mailed on February 14, 2008.

No claims are amended, no claims are canceled, and no claims are added; as a result claims 1-40 are now pending in this application.

§102 Rejection of the Claims

Claims 1-6, 31-36 and 40 were rejected under 35 U.S.C. § 102(b) for anticipation by Trostle (U.S. 5,919,257). Applicants respectfully traverse these rejections.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration, *In re Dillon*.¹

Concerning independent claims 1, 31, 32, 33, and 40:

Applicants believe that the issue of patentability of independent claims 1, 31, 32, 33, and 40 over Trostle is best understood with regard to independent claim 1.

Independent claim 1 includes the following limitations:

causing a first identifier associated with a first user identity to be stored on a machine responsive to a first sales-related event with respect to the network-based transaction facility ...;

detecting a potentially fraudulent activity by detecting a lack of correspondence between the first identifier stored on the machine and a second identifier associated with a second user identity responsive to a second sales-related event with respect to the network-based transaction facility and initiated under the second user identity from the machine.

¹ 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

(Emphasis added.)

In response to the arguments most recently submitted by Applicants, the Final Office Action maintains that that the above limitations are disclosed by Trostle in col. 5, lines 45 – 67 (cited below).

“FIG. 5 is a flow chart illustration of the login process based upon NDS authentication employed in NetWare 4.1. In step 82, a username prompt is presented to the user. In response, the user enters a username, which is transmitted to the server and in step 84 the server compares the entered username against a list of authorized users. If the username is not valid, network access is denied in step 86 and the login process ends. However, if the entered username is on the list, the server returns an encrypted private key to the workstation in step 88. The encrypted private key can only be decrypted with the user's password. In step 90 the server checks if any login restrictions, such as time restrictions, station restrictions, and account lockout restrictions have been violated. These restrictions prevent logins from unauthorized workstations or logins during the wrong time of day. If there are violations, access is denied (step 86). However, if there are no login restrictions, the user is prompted to enter a password in step 92 and the validity of password is determined in step 94².”

Trostle, apparently, relates to a two step login process. Instead of requiring a user to enter his username and password at once, the user is prompted to enter his username first. The username is then transmitted to the server and is validated against a list of authorized usernames. If the username is not among the authorized usernames, the access is denied. Otherwise, an encrypted private key is transmitted to the client system that can only be decrypted with the user password.

Thus, the login process proposed in Trostle apparently relates to denying user access based on a **single unauthorized user id**. On the contrary, independent claim 1 requires “*a first user identity*” and “*a second user identity*”. Furthermore, besides requiring “*a first user identity*” and “*a second user identity*”, independent claims 1 requires “*detecting a potentially fraudulent activity by detecting a lack of correspondence between the first identifier stored on the machine and a second identifier associated with a second user identity*”. Trostle, on the

² Trostle, col 5, lines 45-67

other hand, is concerned with whether its single user id is among the “authorized users”. Thus it is clear that a single user id of Trestle cannot be reasonably characterized as “*a first user identity*” and “*a second user identity*” cited by independent claim 1.

Moreover, Trostle **denies user access** if the user id is not found in the list of authorized users. Contrary to Trostle, independent claim 1 does not require denying user access whether or not there is “*a lack of correspondence between the first identifier stored on the machine and a second identifier associated with a second user identity*”. Instead, independent claim 1 requires “*detecting a potentially fraudulent activity*”.

For at least the reasons stated above, Trostle fails to disclose all limitations of independent claim 1, and therefore the rejection of claims 1, 31, 32, 33, and 40 as anticipated by Trostle is improper and should be withdrawn.

Concerning claims 2-6 and 34-36:

Applicants respectfully submit that claims 2-6 and 34-36 depend directly or indirectly from independent claims 1 and 33. As such, these dependent claims incorporate all the limitations of their parent independent claims. Accordingly, Applicants submit that these dependent claims are patentable for at least the reasons set forth above.

Thus, Applicants respectfully request withdrawal of the rejections of claims 2-6 and 34-36. For brevity, Applicants reserve the right to present further remarks concerning the patentable distinctiveness of such dependent claims.

§103 Rejection of the Claims

In rejecting claims under 35 U.S.C. §103, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. §2142.

In the recent decision of the Supreme Court in *KSR Int’l Co. v. Teleflex Inc.*³, the analysis

³ 127 S.Ct. 1727, 82 USPQ.2d 1385 (2007).

of obviousness previously set forth in *Graham v. John Deere Co. of Kansas City*⁴, was reaffirmed. The Court in *Graham* set out an objective analysis for applying §103 as follows:

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.”⁵

The Examiner must make the factual determinations set forth in *Graham v. John Deere Co. of Kansas City*⁶. The September 2007 Edition of the MPEP adopted this line of reasoning by stating that to combine prior art elements in rejecting a claim, the examiner must resolve the *Graham* factual inquiries. Then, the examiner must articulate the following⁷:

“[a] finding that *the prior art included each element claimed*, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference”.

Concerning claims 7-8 and 37:

Claims 7-8 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Trostle in view of Buchner et al. (Discovering Internet marketing intelligence through online analytical web usage mining, ACM SIGMOD Record archive, Vol. 27, Issue 4, (December 1998), Pages: 51-61), hereinafter Buchner.

Applicants respectfully submit that Trostle and Buchner when combined fail to teach or suggest all of the limitations of the rejected claims. Applicants believe that they showed that Trostle fails to disclose elements of independent claims 1, and 33 from which dependent claims 7-8 and 37 depend. The Final Office Action alleges that Buchner discloses elements peculiar to dependent claims 7-8 and 37 but is silent as to why Trostle and Buchner when combined would teach or suggest elements not disclosed by Trostle.

⁴ 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966).

⁵ The Court in *KSR v. Teleflex*, at page 1730, quoted the analysis of *Graham* from page 18.

⁶ 383 U.S. 1 at 467.

⁷ MPEP § 2143 A

The MPEP states that the prior art reference (or references when combined) need not teach or suggest all the claim limitations. However, according to the same section of MPEP, Office personnel *must explain why the difference(s) between the prior art and the claimed invention would have been obvious* to one of ordinary skill in the art. MPEP § 2141. The Final Office Action does not address the differences between the combination of Trostle and Buchner and the rejected claims. Accordingly, the Final Office Action has failed to explain why the differences between the combination of Trostle and Buchner and the rejected claims would render the rejected claims obvious to one of ordinary skill in the art.

Nevertheless, Applicants have carefully reviewed Buchner but failed to find the language of Buchner that either alone or in combination with Trostle would teach or suggest claims 7-8 and 37. Accordingly, Applicants respectfully request that the obviousness rejection of claims 7-8 and 37 be withdrawn.

Concerning claims 9-19 and 38:

Claims 9-19 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Trostle in view of Buchner as applied to claims 8 and 37 above, and further in view of Miller (Michael Miller, The complete Idiot's Guide to Ebay Online Auctions, copyright July 1999).

Applicants respectfully submit that Trostle, Buchner, and Miller when combined fail to teach or suggest all of the limitations of the rejected claims. Applicants believe that they showed that Trostle and Buchner fail to disclose elements of claims 8, and 37 from which claims 9-19 and 38 depend. The Final Office Action alleges that Miller discloses elements peculiar to claims 9-19 and 38 but is silent as to why Trostle, Buchner, and Miller when combined would teach or suggest elements not disclosed by the combination of Trostle and Buchner.

The MPEP states that the prior art reference (or references when combined) need not teach or suggest all the claim limitations. However, according to the same section of MPEP, Office personnel *must explain why the difference(s) between the prior art and the claimed invention would have been obvious* to one of ordinary skill in the art. MPEP § 2141. The Final Office Action does not address the differences between the combination of Trostle, Buchner, and

Miller and the rejected claims. Accordingly, the Final Office Action has failed to explain why the differences between the combination of Trostle, Buchner, and Miller and the rejected claims would render the rejected claims obvious to one of ordinary skill in the art.

Nevertheless, Applicants have carefully reviewed Miller but failed to find the language of Miller that either alone or in combination with Trostle and Buchner would teach or suggest claims 9-19 and 38. Accordingly, Applicants respectfully request that the obviousness rejection of claims 9-19 and 38 be withdrawn.

Concerning claims 20-30 and 39:

Claims 20-30 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Trostle in view of Buchner and Miller as applied to claims 19 and 38 above, and in further view of Smaha et al (U.S. 5,557,742), hereinafter Smaha. Applicants respectfully traverse these rejections.

Applicants respectfully submit that Trostle, Buchner, Miller, and Smaha when combined fail to teach or suggest all of the limitations of the rejected claims. Applicants believe that they showed that Trostle, Buchner, and Miller fail to disclose elements of claims 19 and 38 from which claims 20-30 and 39 depend. The Final Office Action alleges that Smaha discloses elements peculiar to claims 20-30 and 39 but is silent as to why Trostle, Buchner, Miller, and Smaha when combined would teach or suggest elements not disclosed by the combination of Trostle, Buchner, and Miller.

The MPEP states that the prior art reference (or references when combined) need not teach or suggest all the claim limitations. However, according to the same section of MPEP, Office personnel *must explain why the difference(s) between the prior art and the claimed invention would have been obvious* to one of ordinary skill in the art. MPEP § 2141. The Final Office Action does not address the differences between the combination of Trostle, Buchner, Miller, and Smaha and the rejected claims. Accordingly, the Final Office Action has failed to explain why the differences between the combination of Trostle, Buchner, Miller, and Smaha

and the rejected claims would render the rejected claims obvious to one of ordinary skill in the art.

Nevertheless, Applicants have carefully reviewed Smaha but failed to find the language of Miller that either alone or in combination with Trostle, Buchner, and Miller would teach or suggest claims 20-30 and 39. Accordingly, Applicants respectfully request that the obviousness rejection of claims 20-30 and 39 be withdrawn.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4051 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date May 13, 2008


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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 13 day of May, 2008.

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